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OCT 13 2004

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In re Application of  
SAMUEL ROSE, M.D. (Deceased June 3, 2001) Decision on Petition  
Serial No: 08/782,590  
Filed: 13 January 1997  
Attorney Docket No: 43/24

This letter is in response to the Request to have Final Rejection of March 26, 2004 Withdrawn as Being Premature. The delay in acting upon this petition is regretted.

**BACKGROUND**

This application was filed on January 13, 1997 with original claims 1-87. The examiner restricted claims 1-87 into 15 groups, in the restriction requirement mailed on 23 May 1997.

In the response filed on 29 September 1997, applicants elected group XIV, claims 69-83 with traverse.

A non-final office action was mailed on 25 February 1998 in which claims 1-87 were pending, claims 1-68, 84-87 were withdrawn from consideration and claims were 69-83 rejected.

Final office action was mailed on 25 November 1998, in which claims 69-83 were rejected and claims 1-68, 84-87 were withdrawn.

The application was abandoned on 17 August 1999, because the response filed on 27 May 1999 did not result in allowance of the application.

Applicants have filed a petition to revive the application, which accompanied the request for Continued Prosecution Application on 16 November 1999. The petition was granted on 06 January 2000.

A non-final office action was mailed on 25 May 2000, in which claims 1-87 were pending, claims 69-83 were rejected and claims 1-68, 84-87 were withdrawn from consideration.

A final office action was mailed on 13 February 2001, in which claims 1-87 were pending, claims 69-83 were rejected and claims 1-68, 84-87 were withdrawn from consideration.

A request for Continued Prosecution Application was filed on 13 August 2001.

A non-final rejection was mailed on 05 July 2002, in which claims 69-87 were pending, claims 69-83 were rejected, and claims 84-87 were withdrawn from consideration. NOTE the pending claims 1-68 were not mentioned in the office action.

The amendment filed on 10 January 2003, canceled claims 82 (see page 10 of the response), and claim 83 (see page 5 of the amended claims) and amended claims 69, 71-72, and 75-80.

A final office action was mailed on 01 May 2003, in which claims 69-82 were pending and 69-82 were rejected.

A request for Continued Prosecution Application was filed on 30 October 2003. Along with the request for CPA two sets of claims were filed. One set was marked as Preliminary Amendment for Continued Prosecution Application (set A), which has claims 1-83. Another set of claims (set B) was filed on 30 October 2003, which has claims 1-87. And the claims 69-83 are different in both the sets of claims.

A First action Final rejection was mailed on 26 March 2004, in which claims 1-82, 88 were indicated as pending, claims 1-68 were withdrawn and claims 69-82, 88 were rejected.

In the office action (mailed on 26 March 2004) in page 2 the examiner indicated that claim 83 is renumbered as claim 88 using Rule 37 CFR 1.126. The office action did not mention the two sets of claims. It is not clear which set of claims (set A or set B) was examined by the examiner.

## RELEVANT RULES

### 37 CFR 1.126. Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant. In a single claim case, the claim is not numbered.

### ¶ 6.17 Numbering of Claims, 37 CFR 1.126

The numbering of claims is not accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

### 608.01(s) Restoration of Canceled Matter

Canceled text in the specification can be reinstated only by a subsequent amendment presenting the previously canceled matter as a new insertion. 37 CFR 1.121(b)(4). A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number. 37 CFR 1.121(c)(2). See MPEP § 714.24.

A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 CFR 1.51(b) and was filed before May 29, 2000, or is a design application. There is no other limit to the number of CPAs that may be filed in a chain of continuing applications.

However, only one CPA may be pending at one time based on the same prior nonprovisional application.

RULE § 1.53 Application number, filing date, and completion of application.

(d) Application filing requirements - Continued prosecution (nonprovisional) application

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

(i) The prior nonprovisional application is either:

(A) A utility or plant application that was filed under 35 U.S.C. 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);

## DISCUSSION

The petition and file history have been considered carefully. Upon careful consideration of the file history several issues were noted in this application, which merit discussion before consideration of the Request for Reconsideration.

- a) Which set of claims presented on 30 October 2003 are pending in this application;
- b) Which claims are pending or number of claims pending;
- c) Numbering of the claims;
- d) Whether Finality of the office action mailed on 26 March 2004 is proper or not;
- e) Whether CPA filing on 30 October 2003 is in acceptable condition or not.

a). The preliminary amendment filed on 30 October 2003 along with the Request for Continued Prosecution Application has claims 1-83 (Set A). This set of claims includes the canceled claims 82 and 83 (see the amendment and response filed on 10 January 2003). Further in this set (set A) of claims, claims 69-83 are different from the second set (Set B) of claims.

The second set (set B) of claims 1-87 filed on 30 October 2003, includes claims 84-87, which were not present in the first set (set A) of claims or were originally present in the application. The content of claims 69-83 of set B is different from the set A of claims.

Thus, it is not clear which set of claims are applicants had intended to be considered as pending claims.

b). The amendment and papers filed on 30 October 2003, has two sets of claims. The first set (Set A) has claims 1-83 and the second set (Set B) has claims 1-87. And further set A claims 69-83 are different from the second set B claims 69-83.

In the office action mailed on 26 March 2004, the examiner has not addressed the two sets of claims and renumbered claim 83 under with 37 CFR 1.126. However, it is not clear which claim set was examined and from which set (A or B) claim 83 is renumbered.

In view of the confusing two sets of claims, number of claims and different claimed subject, the claims pending cannot be determined.

c). Numbering of the claims are not accordance with 37 CFR 1.126. Canceled claims 82 and 83 (response filed on 10 January 2003) are added as claims 82 and 83, which is improper. Applicants may add the claims by numbering consecutively beginning with the number next following the highest numbered claim previously presented. In this application it should continue after claim 87.

In view of the above issues the response filed on 30 October 2003 is considered as non-responsive. The office cannot determine which set of claims applicants intend to have examined.

Applicants may wish to review the file to verify the claims that they wish to have examined (the set of claims, properly numbered, and the number of claims).

d). In the office action mailed on 26 March 2004 the examiner considered the filing of the request for continued examination (30 October 2003) as RCE, using form paragraph 7.42.04 in the office action mailed on 26 March 2004. The examiner has examined claims 69-82 and 88 and made the office action final using form paragraph 7.41.03, which is specific for CPA filing. The examiner has considered claim 88 as same as the deleted claim 83 and renumbered the claim according to 37 CFR 1.126.

The office action has not addressed the two sets of claims filed on 30 October 2003. The office action was not clear on which claim (claim 83 from set A or set B) is considered as claim 88. It is not clear whether the examiner has renumbered claim 87 of set B or claim 83 of set B or claim 83 of set A as claim 88. Moreover, because the filing of request for continued examination filed on 30 October 2003 is considered as RCE filing under 37 CFR 1.114, the use of form paragraph 7.41.03 to make the office action final is an error.

It is noted that in the PTOL-326 (Office Action Summary) the boxes 4 and 6 were not checked by the examiner, however examiner has filled the boxes stating which claims were considered as pending and withdrawn (box 4) and filled the box stating which claims were considered as rejected.

Thus for the reasons discussed above the final rejection of claims 69-82 and 88, mailed on 26 March 2004 is improper and the office action has been vacated.

e) Applicants have requested Continued Prosecution Application on 30 October 2003, on a prior CPA filed on 13 August 2001. According to 37 CFR 1.53 (d), CPA filing requirements CPA can not be filed on a prior CPA which was filed after 29 May 2000. In this application the previous CPA was filed on 13 August 2001, which was after the 29 May 2000.

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), **the Office will automatically treat the improper CPA as an RCE of the prior application** (identified in the request for CPA) under 37 CFR 1.114.

The filing of request for Continued Prosecution Application on 30 October 2003 has now been treated as RCE under 37 CFR 1.114.

Turning now to the request filed on 21 April 2004 that applicant is entitled to a new requirement of restriction based on the new set of claims filed on 30 October 2003:

35 U.S.C. 132(b) and 37 CFR 1.114 provide continued examination of an application (and not examination of a continuing application), the applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., **applicant cannot switch inventions**) (see 37 CFR 1.145).

Thus, applicants cannot switch the inventions. The original restriction carries over and only claims directed to the same invention examined in the previous office action will be examined in the RCE filing under 37 CFR. 1.114. Applicants arguments regarding the requirement of new restriction are moot in view of filing of RCE under 37 CFR. 1.114.

## DECISION

Applicant's Request for withdrawal of office action mailed on 26 March 2003 is **DISMISSED** for the reasons set forth above.

The final office action mailed on 26 March 2004 has been vacated in view of the office errors in processing improper CPA filing and non-responsive amendment filed on 30 October 2003.

If an applicant files a request for a CPA of an application to which CPA practice no longer applies and the CPA satisfies the requirements of 37 CFR 1.114 to be a proper RCE, but the applicant does not want the request for a CPA to be treated as a RCE under 37 CFR 1.114 (e.g., the CPA is a divisional CPA), the applicant may file a petition under 37 CFR 1.53(e) requesting that the improper CPA be converted to an application under 37 CFR 1.53(b).

Applicants have **ONE MONTH** from the mailing date of this petition decision to file a proper amendment with the correct set of claims to be examined in this application, and/or to file a petition under 37 CFR 1.53(e) requesting that the improper CPA be converted to an application under 37 CFR 1.53(b).

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Any request for consideration must be filed within two (2) months from the mailing date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.



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